

Remarks

Applicants and their undersigned attorney have reviewed the first Office Action of October 11, 2006 in the above-identified patent application, together with the prior art references cited and relied on by the Examiner in the rejections of the claims. Applicant has amended the application and believes that the invention is not anticipated by, and is not obvious in light of, the prior art. Reexamination and reconsideration of the application, and allowance of the claims is respectfully requested.

Applicant would first like to thank the Examiner for the very careful and proficient review of the present application. The Examiner was able to locate several typographical errors. Replacement paragraphs have been submitted to amend these errors.

The Examiner has rejected the Declaration because "it does not identify the city and either state or foreign country of residence of each inventor." However, in a response to a Notice to File Missing Parts, a Declaration in compliance with 37 CFR 1.53 was entered on August 30, 2004. The application has been published with inventor's city and state of residence. (See US Published Appln. No. 2005/0011136). Withdrawal of the objection to the Declaration is respectfully requested.

The formal objections to the drawings and claims have also been addressed. Reference number 102 has been removed from Figure 7. Use of the reference number 102 in the specification could not be located. Therefore, reference number 102 was also removed from Figure 9 and replaced with

reference number 90. In Figure 11, element 90 was incorrectly identified. It appears the element should have been labeled as element 91. Appropriate corrections have been made, and replacement sheets are attached herewith. Applicant has not located any additional errors in the figures. However, Applicant would appreciate the identification of any additional errors that the Examiner might locate. Otherwise, withdrawal of the formal objections is respectfully requested.

Multiple claims are objected to as including reference characters illustrated in the drawings but that are not enclosed by parentheses (see MPEP § 608.01(m)). The claims refer, for example, to a dimension 'D'. The use of parentheses is thought to reduce the confusion with other numbers or characters that may appear in the claims. The references to the dimensions illustrated in the figures are now enclosed in parentheses. Applicant notes that a hinge in Figure 9 is illustrated as having a dimension D2. The further objection to claim 68 does not appear to merit an amendment at this time.

Claims 55 and 56 are rejected under 35 U.S.C. 112, first paragraph. The claims depend from independent claim 42. Claim 42 includes a gutter cover clip with a first throat portion to engage the curl of a gutter cover and a second throat portion to engage the vertical wall of a gutter. In claim 42, the location and orientation of the second throat is not limited. In the figures, it is clear that there could either be, but the invention is not necessarily limited to, a substantially horizontally aligned throat (element 72 in Figure 6), a substantially vertically aligned throat (element 91 in Figure 6), or both throats.

In the language cited by the Examiner, the specification states that the clip can either *alternatively* or additionally include the vertical slot. There is no requirement in claim 42 that both throats 72 and 91 exist on the same clip at the same time.

Claim 55 includes the ability of the clip to lock onto the vertical-gutter wall and also states that the walls or jaws of the second throat are essentially parallel to the vertical gutter wall. The Examiner locates the language in the specification that supports the walls as being substantially vertical. The 112 rejection is predicated on the allegation that “third and fourth jaws” cannot be parallel to the vertical wall of the gutter *if* the third and fourth jaws are perpendicular to the illustrated vertical jaws/walls. However, no passage in the specification or claims supports such a reading. Claim 42 does not require that the third and fourth jaws be perpendicular to any other walls/jaws. The horizontal through is one alternative embodiment and need not be included on the clip. The specification, as cited the Examiner, supports that certain embodiments of the invention will include only one throat, and that the lone throat might be aligned vertically with substantially vertical walls. One of ordinary skill in the art could not reasonably question whether the Applicant had possession of the claimed invention upon reviewing the specification. Withdrawal of the 112, first paragraph, rejection is respectfully requested.

Claims 42-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner points out that the language of “a solid sheet having one longitudinal edge thereof formed into a curl and wherein the cover

extends downwardly and outwardly from the lowermost edge of a rood” is indefinite because it is unclear whether the solid sheet is the cover or if it is an element different than the cover. The Examiner correctly interprets the cover to be constructed of the solid sheet. The structure of a typical gutter cover is referred to in the prior art portion of the specification and in U.S. Patent No. 4,455,791. Applicant has amended the claims to clarify the claim language in conformity with the Examiner’s interpretation of the claim.

Likewise, the Examiner correctly identified that the phrase “having a width” in claim 43 might refer to one of two preceding elements in the claim. The Examiner correctly identified the element “having a width (D3)” as the hinge. Applicant’s amendments for claim 43 again address the clarity of the language used in the claim.

Claims 44 and 45 lack proper antecedent basis for the term “the thickness.” As the Examiner implies, the term was intended to be “the width.” Appropriate corrections have been made.

Claim 56 also incorrectly interchanges the term “wall” and “jaw.” Appropriate corrections have been made.

The final 112, second paragraph, rejection charges that claim 75 is indefinite. Additional errors were located and corrected within claim 75. For instance, it appears that the phrase “the width (D6)” lacked an antecedent basis.

Turning now to the rejections under 35 U.S.C. 102, claims 42, 55, 61-62, and 65 are rejected as being anticipated by Stevens (U.S. Patent No. 6,735,907). Applicant is familiar with Stevens as the Assignee of record supplied Stevens with the cover and clip taught in U.S. Patent No. 4,455,791, upon which the '907 application appears to be based. Applicant also identified the Stevens reference in an Information Disclosure Statement. The subject gutter-cover system improves upon the Stevens design in several ways.

Significantly, the clip in Stevens is attached via a fastener to a gutter (see the Abstract of the Invention for the '907 patent). The present invention eliminates the need to use fasteners to secure the clip to the gutter. There are considerable advantages provided by such a design including, among other things, lower installation times, less damage to the customer's gutters, a reduction in manufacturing costs, and the elimination of the fastener reduces the possibility of any interference with the flow of water that might arise with the use of fasteners. Fasteners are also not as aesthetically pleasing to customers relative to the new non-fastener system in the subject application.

The '907 patent refers to Applicant's prior product. Stevens argues that "because the clip used in the Elko system is not securely attached to either the gutter or the cover, it can become dislodged during stormy or windy weather" (Col. 2, lines 38-40). Without a fastener to secure the clip, Stevens is arguing that the clip could not be properly secured on the gutter. Stevens is, therefore, teaching away from the present invention as the subject invention does not employ a fastener to positively connect the clip to the gutter.

The invention of independent claims 42 and 65, and those claims depending therefrom, includes the locking lever that is adapted to be bent at a hinge to bring a jaw into a locking position against a gutter. The Examiner alleges the existence of a locking lever (d) in the Stevens clip. The locking lever (d) is said to be adjacent to third (b) and fourth (e) jaws. The Examiner states that the locking lever (d) is joined to the body (a) portion by a hinge (e). The Examiner further contends that the locking lever (d) is adapted to be bent at said hinge (e) to bring said third jaw (b) into a locking position against the gutter. The Examiner does not cite any language in the specification in support of this characterization of the Stevens reference.

The element the Examiner has illustrated as lever (d) in the Stevens specification is labeled as element 50 in the '907 patent. Element 50 is defined as the vertical portion of the Stevens clip's body (see, e.g., Column 5, lines 60-65 and Column 9, lines 1-7). Nowhere in the specification does Stevens discuss the area (d) of the clip as being a lever or that the specified area of the clip is adapted to be bent around a hinge. The Stevens specification does not identify the area labeled (e) as a hinge. Area (e) is flanked by a pin hole 56 and a score line 48 that would suggest area (e) is anything but adapted to be bent as bending the clip around that point would likely distort the pin hole and score line.

In fact, Stevens goes into some detail that the clip is to be pulled onto the gutter using a specific type of pliers that engage the pin hole 56 (see Column 9, lines 1-16). The installation technique does not discuss a lever adapted to be

bent at a hinge to lock the clip against the gutter. The Stevens specification even argues that where a clip does not include a fastener, the clip is not lockable or securely attached to the gutter (Col. 2, lines 38-40). It is a stated object of Stevens "to provide a rain gutter which is affixed in place by at least one fastener to prevent movement of the cover" (Col. 3, lines 38-40). Clearly Stevens does not lock onto the gutter other than by the use of a fastener whereas the subject invention provides a locking lever.

As Stevens does not disclose each and every element of the independent claims 42 and 65, Stevens cannot anticipate claims 42, 65 or any claims depending therefrom. In addition, claim 55 indicates that the throat of the subject clip is substantially vertical. The Examiner has not indicated any such teaching in Stevens. Reconsideration and withdrawal of the claims is respectfully requested.

In the present Office Action, claims 43-48, 56, 63, 66-69 and 74-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Doussot et al. (U.S. Patent No. 5,426,832). As noted above, applicant disagrees that Stevens teaches a locking lever joined to the body portion by a hinge wherein the locking lever is adapted to be bent at the hinge to bring a jaw into a locking position against a gutter. The '832 reference also does not teach this feature. In addition, an obvious consideration of nonobviousness would be that Stevens teaches away from a clip being able to securely lock onto a gutter without resorting to a fastener. For at least this reason, the relevant claims are not obvious in light of the cited reference.

Claims 50 and 54 are rejected under 35 U.S.C 103(a) as being unpatentable over Stevens in view of Holbrook (U.S. Patent No. 6,347,780). Again, the elements of the independent claim are not taught by Stevens or Holbrook, alone or in combination. Therefore, dependent claims 50 and 54 cannot be obvious under 35 U.S.C. 103.

In addition to the lack of teaching the elements of the present invention, Applicant believes the cited reference cannot properly be combined to render the present invention obvious under §103. The Doussot and Holbrook references are non-analogous to the subject invention, and the Office Action relies upon impermissible hindsight analysis. The Office Action has not established why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter.

I. Non-analogous art

In order to rely upon a reference for a 35 U.S.C. 103 obviousness-type rejection, the cited reference must be analogous. Here, however, the cited art is not within the field of the applicant's endeavor and is not reasonably pertinent to the particular problem the inventor was solving (see, e.g., In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986)). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See

also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). The Federal Circuit has elaborated by stating “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); see also *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved); (MPEP 2141.01(a)(1)).

It is understood that the Examiner bears the burden in proving a prima facie case of obviousness under 103. A conclusive statement that a reference is analogous is unlikely to meet that burden.

The '832 and '780 patents teach non-analogous inventions. Doussot teaches a pivoting fixing clip, particularly for a vehicle seat cushion. The '832 patent is classified in classes 24 and 403. The Examiner for the '832 patent during prosecution considered the Field of Search to consist of classes 24, 403 and 248. In contrast, the subject application is provisionally classified in Class 52. Therefore, the Patent Office has at least indicated that the disclosed inventions are non-analogous in terms of structure and function.

Likewise, Holbrook teaches a device for hanging decorative lighting. Holbrook is classified in class 248. The Examiner for the Holbrook reference only searched class 248.

Applicant believes it is self-evident that Doussot and Holbrook do not serve the same function as the present or share the same structure. While the different PTO classifications for the two references are important, "[t]he similarities and differences in structure and function of the inventions...carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (See MPEP 2141.01(a)(2)). Here, it cannot logically be stated that a reference related "to a manually operated fixing clip for joining together removably so that they can pivot two elements, one of which carries the clip and the other an anchoring rod, forming a pivot pin, and intended to interact with the clip" (see the first paragraph of the '832 patent) would have "commended itself" to the Applicant's attention while considering the problem of creating an "improved clip for spacing a gutter cover from the outer edge of the gutter to maintain a desired small space between the gutter cover and the outer wall of the gutter" (see "Background" paragraph of the subject application). A "system to easily install and remove hangers for a string of decorative lights around the house" is not analogous merely because the decorative light hanger might be attached to a gutter. There is practically no structural or functional overlap between Doussot, Holbrook and the present application, and they cited references are definitely not part of the same endeavor.

The Doussot and Holbrook references have not been cited in the same classification area as the subject invention, do not serve the same function, have dissimilar structures, and would not commended themselves to the Applicant's attention while considering the problem of creating a gutter cover clip. The references are, therefore, non-analogous to the subject invention or even to the Stevens reference. The Office Action provides no objective basis as to why the references should be considered to be analogous. As such, it is improper to rely upon the cited references in order to reject the subject application. Reconsideration and withdrawal of the rejection under 103 is requested.

2. Hindsight Construction

While the cited references must be analogous in order to properly form a part of a patent application rejection, it is also respectfully submitted that the proper application of the obviousness test of 35 U.S.C. 103 requires one to picture the person of ordinary skill in the art as having the (analogous) references before him/her without any knowledge of the applicant's invention. The necessity of avoiding hindsight reconstruction was well stated by the Court of Customs and Patent Appeals in the case of In re Rothermel and Waddell, 125 USPQ 323 at 331 (1960), wherein the court noted:

The examiner and the Board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in light of appellant's disclosure...It is easy now to attribute to this prior art the knowledge that was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill of the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a

rejection of claims, it is not the type of rejection which the statute authorizes. 35 U.S.C. 103 is very specific in requiring that rejection on the grounds the invention would have been obvious must be based on a comparison between the prior art and the subject matter as a whole at the time the invention was made.

This requirement for a detached viewing of the teachings and suggestions of the references necessitates that Examiners study the references and determine what their teachings would be to a person who has not read applicant's application. If the references are considered in the foregoing manner, it is most respectfully submitted that they do not provide a proper teaching, suggestion, or motivation to anticipate or render obvious the claims rejected under 103. Quite simply, a person of skill in the art would not have thought to combine a gutter cover clip with a "manually operated removable and pivoting fixing clip" or a decorative light hanger in the manner the Examiner suggests.

Hindsight reconstruction is impermissible because it is human nature to identify elements in the prior art and conclusively state that they suggest or teach the elements of a problem's solution or an invention. Once the solution is known, the tendency to call the solution obvious is a well-documented phenomenon. Yet, most inventions consist, at least in part, of elements found in the art. Here, the Office Action argues that the Doussot reference discloses a bending slot in a body portion. The Examiner reasons that because the references are analogous art, "it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the

clip of Stevens to include a bending slot in said body portion, said bending slot being located above said second throat so that said hinge is between said second throat and said bending slot and having a width (D3) whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter as taught by Doussot et al. to further clamp down on an object that needs to be secured.” If the references were analogous, this is insufficient reasoning to explain obviousness under 103.

The Examiner’s conclusion does not meet the Patent Office’s burden of proof as the Office Action does not provide a reason for modifying the references cited by the Examiner in the manner suggested by the Examiner **except** to arrive at applicant’s specifically defined construction, taught only by applicant’s disclosure. Statements such as “it would have been an obvious design choice” do not provide the type of objective evidence of a teaching, suggestion, or motivation that is required by section 103. The Action does not establish what is “one of ordinary skill in the art.” As such the present 103 rejections are merely hindsight reconstruction of the Applicant’s invention. Applicant also notes that simplicity does not mitigate against patentability. In Universal Athletic Sales Company v. American Gym, Recreational and Athletic Equipment Corporation, Inc., 187 USPQ 104, the court stated, “We are cautioned that the mere simplicity of the device, though it may suggest obviousness, is not by itself a reliable test of obviousness, as many things will seem obvious when viewed with the advantage of hindsight.”

Notwithstanding the Applicant's objections noted above, the Office Action further rejects a number of claims in view of Applicant's Response to Restriction Requirement wherein the Applicant stated that the figures of Groups 2-7 would be obvious over each other within the meaning of 103. The Examiner's argument is that if the rejection over the cited references were proper for some claims, the rejection can be extended to other claims based on the applicant's statement regarding the figures in the response to the restriction requirement.

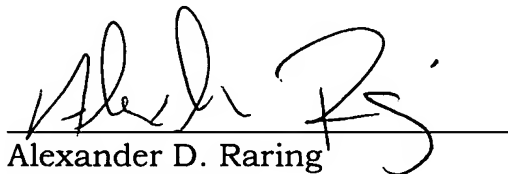
Stevens does not anticipate the present invention under 102, as discussed above. Nor can Applicant's own disclosure be used to modify Stevens in order to arrive at the elements taught only in the subject application.

Applicant also notes that a patent application can contain figures that would be obvious in relation to one another even where the figures might disclose different aspects of the overall invention. The various figures might be encompassed by a single claim (such as claim 42 in the present application). Merely acknowledging this fact would not obviate the Patent Office of the burden of establishing the obviousness of each claim individually relative to a cited reference.

For any one or more of the foregoing reasons, Applicant respectfully submits that the claims are in condition for allowance. Favorable action is requested hereon.

It is believed that there are no fees associated with this filing. However, in the event the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 50-2127.

Respectfully Submitted,



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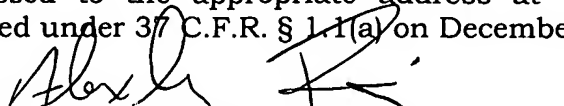
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the appropriate address at the U.S. Patent and Trademark Office required under 37 C.F.R. § 1.1(a) on December 5, 2006.

by:


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